

### REMARKS

This responds to the Office Action dated on November 4, 2005. No claims are amended, cancelled or added. As a result, claims 1-79 remain pending in this patent application.

#### Remarks Regarding Applicant's Response to Restriction

Applicant thanks the Examiner for withdrawing the Restriction Requirement. Applicant does not admit that the claims in Group I are not patentably distinct from Group II, as asserted by the Office Action. (See Office Action ¶ 5.) Nonetheless, Applicant believes that withdrawal of the Restriction Requirement is proper.

#### §112 Rejection of the Claims

Claims 1-79 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

The Office Action asserts:

In view of the nature and scope of Applicant's invention, Applicants present an unreasonable number of claims which are repetitious and/or multiplied, the result of which confuses rather than clarifies the claimed subject matter. Therefore, in accordance with MPEP § 2173.05(n), claims 1-79 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph based on undue multiplicity. The Examiner respectfully requests Applicants choose approximately 20 claims for examination.

(Office Action ¶¶ 8-9.) Applicant respectfully traverses. As an initial note, the present case includes only 79 claims, including independent claims 1, 17, 37, 51, 55, 62, and 69, for which Applicant paid \$699 in excess fees in order to obtain examination of such claims. The present rejection denies Applicant the benefit of such examination for no apparent reason other than their number, without providing any justification or reasoning. The Office Action relies upon the following cited portion of the MPEP:

Where, *in view of the nature and scope* of applicant's invention, applicant presents an *unreasonable* number of claims which are *repetitious and multiplied*, the net result of which is to *confuse* rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112, second paragraph, may be appropriate. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), "*applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged.*" Such latitude, however, should not be

extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis *of the relevant facts and circumstances in each individual case.*" See also *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969). Undue multiplicity rejections based on 35 U.S.C. 112, second paragraph, *should be applied judiciously and should be rare.*

(MPEP § 2173.05(n) (emphasis added).) However, the Office Action provides absolutely no reasoning explaining any of the following:

- How the nature and scope of Applicant's invention was considered by the Examiner;
- Why the number of claims presented are being deemed unreasonable under the particular circumstances of the case;
- Which particular claim language is being deemed repetitious and/or multiplied;
- How the claims confuse to such a degree as to cause a maze of confusion;
- Why the number of claims specified by the rejection (i.e., 20) avoids a finding of undue multiplicity.

Thus, the present rejection fails the MPEP's requirement that a rejection for undue multiplicity must be applied on the basis of the relevant facts and circumstances in each individual case. More importantly, it deprives Applicant of any ability to amend the claims to avoid the rejection by removing its underlying causes. If completely unsubstantiated undue multiplicity rejections—like the present rejection—were permissible as a basis for limiting the number of claims to be examined to 20, they would render the Patent Office's excess claim fees for examination completely meaningless.

The present invention is complex. Therefore, multiple different forms of claims are deemed required to adequately protect the invention. The MPEP section relied upon by the Office Action was written based on old case law (*In re Chandler and Wright*) that has apparently not been followed. Further cases recited in MPEP 2173.05(n) include *In re Flint*, 162 USPQ 228 which denied the multiplicity rejection because the claims differed from one another and that the presentation of the claims was not confusing. *In re Wakefield*, 164 USPQ 636 states at 639 that: "It is rarely possible to determine necessity for narrower claims at the time of prosecution. An applicant often does not know all the prior art which may be asserted against his broader claims when he litigates his patent. Further, he is never sure that the broader claims will not be

successfully attacked on other grounds when litigated in the courts. See, e.g., *Graver Tank v. Linde Air Products*, 336 U.S. 271, 80 USPQ 451 (1949). Moreover, there is no statutory authority for rejecting claims as being 'unnecessary'. For these reasons, an applicant should be allowed to determine the necessary number and scope of his claims, provided he pays the required fees and otherwise complies with the statute." Thus, it appears that the Courts have moved away from this type of rejection. In the case of software, there is even a further need for different types of claims. Computer related inventions may need to include method and computer readable medium claims. All have different sets of potential direct infringers. There was no way that *In re Chandler and Wright* could anticipate today's reality, but *In re Flint* and *In re Wakefield* started to. Accordingly, Applicant respectfully requests withdrawal of this rejection and examination of all of pending claims 1-79 and that a new First Office Action, or a Non-final Second Office Action be provided.

In light of the requirement in MPEP § 2173.05(n) that the Applicant's reply "must include a selection of claims for purpose of examination, the number of which may not be greater than the number specified by the examiner," Applicant provisionally selects, *with traverse*, the following twenty claims (the number specified by the Examiner) for examination: claims 1, 2, 13, 14, 15, 17, 19, 20, 21, 22, 23, 24, 37, 51, 55, 62, 69, 70, 73, and 76. However, Applicant respectfully declines to cancel or withdraw the other claims, and Applicant reserves all rights to petition and/or appeal the present rejection and any withdrawal of any claims by the Examiner, such as may be based upon the present rejection.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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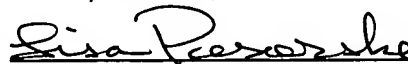
Date February 3, 2006

By   
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of February, 2006.

LISA POSORSKE

Name



Signature